Paper No. 21
HRW

THIS DISPOSITION IS NOT CITABLE AS
PRECEDENT OF THE TTAB OCT. 20,99

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Eco Soil Systems, Inc.

v.

The Atlantic County Utilities Authority

Opposition No. 105,231
to application Serial No. 75/016,421
filed on November 6, 1995

Neil F. Martin of Brown, Martin, Haller & McClain
for Eco Soil Systems, Inc.

Timothy D. Pecsenye of Blank, Rome, Comisky and McCauley
for The Atlantic County Utilities Authority.

Before Hohein, Wendel and Bottorff, Administrative Trademark Judges.

Opinion by Wendel, Administrative Trademark Judge:

The Atlantic County Utilities Authority has filed an application to register the mark ECOSOIL for "compost derived from the composting of vegetative waste."[1]

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[1] Serial No. 75/016,421, filed November 6, 1995, with claimed first use dates of March 1993.

Eco Soil Systems, Inc. has filed an opposition to registration of the mark under Section 2(d), 15 USC §1052(d), on the ground of likelihood of confusion. Opposer alleges use since at least September 1987 and ownership of a registration for the ECO SOIL SYSTEMS and design mark depicted therein[2] for consultation and soil analysis services for commercial and residential soil treatment, including golf course and farmland soil treatment; use of the ECO SOIL SYSTEMS mark for particulate and liquid fertilizers since at least 1990; and a likelihood of confusion if applicant is permitted to register and use its ECOSOIL mark in connection with applicant's goods.

Applicant, in its answer, denied the salient allegations of the notice of opposition.

The Record

The record consists of the file of the involved application; the trial testimony deposition of Jeffery A. Johnson, president and general manager of opposer's golf turf division for two years and prior to that president and chief operating officer of opposer since 1990, with

[2] Reg. No. 1,545,799, issued June 27, 1989, for the mark with a claimed first use date of September 12, 1987 and a claimed first use in commerce of February 5, 1988. Combined Section 8 & 15 affidavit filed and accepted; disclaimer made of the phrase "SOIL SYSTEMS."

accompanying exhibits; and opposer's notice of reliance on a certified status and title copy of its pleaded registration and its requests for admission, accompanied by the declaration of opposer's counsel with respect to applicant's failure to respond thereto. Opposer filed a brief on the case, but an oral hearing was not requested. Applicant filed no brief.

Mr. Johnson testified that prior to joining opposer in 1990 he had visited facilities of opposer in 1989 and had seen evidence of use of the ECO SOIL SYSYTEMS notation on fertilizer bags and on jugs containing liquid fertilizers; that from customer contacts he had reason to believe that the mark had been used on fertilizers since incorporation of the business in 1987, but in an application filed for registration of the mark for fertilizers,[3] the claimed date of first use was set forth as "as early as 1990," it being restricted to the personal knowledge of Mr. Johnson; that opposer's fertilizers range from pure organic fertilizers to synthetic fertilizers, and include mixtures thereof, with the organic fertilizers being made from both animal products and vegetable byproducts; that in addition to being a trade name for opposer, ECO SOIL SYSTEMS is used to identify both the services and products of opposer, with Exhibit 5 consisting of representative examples of this usage; that

the reversed format depicted in opposer's registration is sometimes used on products as well as services, but the word format ECO SOIL SYSTEMS is more commonly used on fertilizers; that most of opposer's marketing is done by salesman on a one-to-one basis; and that in 1997 the approximate sales volume for the ECO SOIL SYTEMS fertilizers was around one million dollars.

The requests for admission which opposer served upon applicant, and which are deemed admitted under FRCP 36 in view of applicant's failure to respond thereto, contain admissions of the following relevant facts:

> The channels of trade for *Ecosoil* products are the same as the channels of trade for the Opposer's *Eco Soil Systems* products (Req. No. 2);
>
> Compost and particulate fertilizers are both used from time to time to treat at least some of the same soil conditions (Req. No. 4);
>
> Applicant is aware of persons who are actually confused, and believe that *Ecosoil* products emanate from the same source as *Eco Soil Systems* products (Req. No. 8); and
>
> The nature of the products on which Applicant uses or proposes to utilize the mark *Ecosoil* are substantially the same as the type of product on which the mark *Eco Soil Systems* is utilized (Req. No. 9).

The requests directed to conclusions made by applicant with respect to the ultimate issue of likelihood of confusion or with respect to the likelihood that purchasers would assume a common source for the respective products are not,

[3] Serial No. 75/254,040 for ECO SOIL SYSTREMS for particulate and

however, admissions of fact upon which opposer can rely and accordingly have not been considered. See Interstate Brands Corp. v. Celestial Seasonings, Inc., 576 F.2d 926, 198 USPQ 151 (CCPA 1978) [facts alone can be admitted, not legal conclusions].

The Opposition

Insofar as priority is concerned, opposer's submission of a status and title copy of its registration for the mark ECO SOIL SYSTEMS and design, showing that this registration is subsisting and owned by opposer, is sufficient to establish priority with respect to the services recited in the registration. King Candy Co., Inc. v. Eunice King's Kitchen, Inc., 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). Opposer, however, is relying almost exclusively upon use of the mark ECO SOIL SYSTEMS for particulate and liquid fertilizers, and thus prior common law usage of this mark for these goods must be proven.

Having introduced no evidence with respect to use of its ECOSOIL mark, applicant is entitled only to the filing date of its application, namely, November 6, 1995, as the earliest date upon which it can rely in this proceeding. Opposer's witness Mr. Johnson has testified to observing the presence of the mark ECO SOIL SYSTEMS on bags of fertilizer produced by opposer as early as 1989 and to attesting in an

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liquid fertilizers, which now stands abandoned.

application for registration of the mark for fertilizers to use since "at least as early as 1990." Mr. Johnson has also made of record brochures and labels demonstrating present use of ECO SOIL SYSTEMS as both a service mark and trademark (Exhibit 5). Inasmuch as this evidence stands uncontested, we find that opposer is entitled to rely upon a first use date of at least 1990, a date clearly prior to the 1995 date upon which applicant may rely, and even prior to applicant's claimed first use date in 1993.

Thus we turn to the issue of likelihood of confusion and to those of the du Pont factors which are most relevant to the circumstances at hand. See In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

We agree with opposer that, on the basis of the admissions set forth above, the respective goods of the parties must be considered to be highly similar and capable of being used to treat similar soil conditions. Mr. Johnson has further testified to the similar composition of certain of its fertilizers and applicant's compost. The channels of trade for the respective products have been admitted to be the same.

Accordingly, the key factor in this case is the degree of similarity of the marks being used by opposer and applicant, namely, ECO SOIL SYSTEMS and ECOSOIL on their respective soil treatment products. In comparing the marks,

we are guided by the general principle that the greater the degree in similarity of the products, the lesser the degree of similarity of the marks required for there to be a likelihood of confusion as to source or sponsorship. See Century 21 Real Estate Corp. v. Century Life of America, 970 F.2d 874, 23 USPQ2d 1698 (Fed. Cir. 1992). It is equally well established that, although the marks must be considered in their entireties, there is nothing improper in giving more or less weight to a particular feature of a mark. In re National Data Corp., 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985).

As such, we find that applicant's mark ECOSOIL and opposer's mark ECO SOIL SYSTEMS create similar commercial impressions. The dominant term in each mark is ECOSOIL (or in separated form ECO SOIL). Neither the descriptive term SYSTEMS not the design element, if used, is sufficiently distinctive to alter the overall commercial impression created by opposer's mark, so as to make applicant's mark distinguishable therefrom. See In re Dixie Restaurants Inc., 105 F.3d 1405, 41 USPQ 1531 (Fed. Cir. 1997).

Accordingly, since the weight of these three factors falls squarely in opposer's favor,[4] and since applicant has

[4] While opposer also argues that its mark has gained fame in view of the length of use and extent of sales, the evidence clearly is not sufficient to show that opposer's mark is famous or even a strong mark in the relevant field. Thus we do not find consider this to be a factor to be added to the balance in opposer's

offered no evidence which might be weighed in its favor with respect to any other factor, we find that opposer has established that there is a likelihood of confusion.

Decision: The opposition is sustained and registration is refused to applicant.

G. D. Hohein

H. R. Wendel

C. M. Bottorff

Trademark Administrative Judges,
Trademark Trial and Appeal Board

favor. On the other hand, applicant's admission with respect to actual confusion may be considered sufficient to weigh this factor in opposer's favor.